

REMARKS

I. Overview

Claims 1-58 are pending in the present application. Applicant thanks the Examiner for the indication that dependent claim 54 would be allowable if rewritten in independent form. Applicant also notes that claim 31 had been previously indicated as allowable in prior office actions, and thus it is believed that claim 31 remains allowable over the art of record. Claims 1, 12, and 26 have been amended. The issues raised by the Examiner in the Non-Final Office Action of March 22, 2007 (*Office Action*) are as follows:

- Claim 54 stands objected to as being dependent upon a rejected base claim;
- Claim 55 stands objected to due to informalities;
- Claims 1-31 stand rejected under 35 U.S.C. § 112, first paragraph;
- Claims 1, 2, 4, 6, 7, 10-17, 23, 26, 27, 32, 33, 36, 41-43, 47, 48, 52, and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0133558 (*Kung '558*) in view of U.S. Patent Application Publication No. 2002/0071537 (*Gainsboro '537*);
- Claims 3 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and U.S. Patent No. 6,876,647 (*Cell*);
- Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and U.S. Patent No. 6,795,444 (*Vo*);
- Claims 8, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and U.S. Patent No. 6,816,469 (*Kung '469*);
- Claims 9, 21, 35, 49, and 55-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and U.S. Patent No. 6,687,360 (*Kung '360*);
- Claims 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537*, *Cell*, and U.S. Patent No. 6,445,682 (*Weitz*);
- Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537*, *Cell*, *Weitz*, and U.S. Patent Application Publication No. 2001/0028649 (*Pogossiants*);
- Claims 20 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and *Pogossiants*;

- Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* '558 in view of *Gainsboro* '537 and *Weitz*;
- Claims 34, 37, 39, 44, 45, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* '558 in view of *Gainsboro* '537 and U.S. Patent No. 6,611,583 (*Gainsboro* '583);
- Claims 38, 39, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* '558 in view of *Gainsboro* '537 and U.S. Patent No. 5,907,602 (*Peel*); and
- Claims 40 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* '558 in view of U.S. Patent Application Publication No. 2003/0023714 (*Ziegler*).

In response, Applicant respectfully traverses the outstanding claim objections and rejections, and requests reconsideration and withdrawal in light of the remarks presented herein.

II. Claim Amendments

Claims 1, 12, and 26 have been amended to recite the terms “subject to said usage restriction,” “subject to said use restriction,” and “subject to said usage restriction,” respectively. No new matter has been presented with these amendments, as the added language finds ample support throughout the Specification as originally filed. *E.g.*, *Specification*, at p.5, lns. 12-17.

III. Claim Objections

Claim 55 stands objected to due to informalities. *Office Action* at p. 2. Particularly, the Examiner states that “[c]laim 55 is identical to claim 9. Both of them depend from claim 1.” *Id.* Applicant respectfully notes, however, that claim 55 is *not* identical to claim 9. For example, claim 55 requires that an account be associated with a personal identification number (PIN), which is not a requirement of claim 9. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection of record with respect to claim 55.

IV. Claim Rejections Under 35 U.S.C. § 112, first paragraph

Claims 1-31 stand rejected under 35 U.S.C. § 112, first paragraph. *Office Action* at p. 2. According to the Examiner, these claims “contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) . . . had possession of the claimed invention” because claim 1 recites “switching means operable under control of said programmable control computer,” whereas a portion of the specification discloses that “the programming for the computer is not all performed by the computer at the site.” *Id.* at pp. 2 and 3.

Although the Specification states that the programming for the computer is not entirely performed by the computer, it does not state that there can be no programming at all being performed by the computer. To the contrary, the Specification clearly shows an embodiment wherein several control functions (*e.g.*, routing, billing, check pin) are distributed to remote locations, and nonetheless the claimed switching means is still under control of the programmable control computer. *E.g.*, *Specification* at p. 6, lns. 6-12; FIGURE 4, items 12 and 20. Therefore, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 112 rejection of record with respect to claims 1-31. Also, in view of the foregoing, Applicant respectfully notes that claim 31 should be in immediate condition for allowance.

V. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-30 and 32-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of references. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

It is well settled that “[t]he examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” M.P.E.P. § 2142. To make a *prima facie* case of obviousness, the Examiner must determine the “scope and content of the prior art,” ascertain the “differences between the prior art and the claims at issue,” determine

“the level of ordinary skill in the pertinent art,” and evaluate evidence of secondary considerations. *Graham v. John Deere*, 383 U.S. 1, 17, (1966); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007); *see also* M.P.E.P. § 2141. When determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I).

The Supreme Court in *KSR* stated that it is “important [for an examiner] to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S. April 30, 2007). The Court indicated that there should be an “explicit” analysis regarding “whether there was an *apparent reason* to combine the known elements *in the fashion claimed* by the patent at issue.” *Id.* (emphasis added). Further, the Court did not reject the use of “teaching, suggestion, or motivation” test as a factor in the obviousness analysis, but rather stated that this test may be indicative of non-obviousness under 35 U.S.C. § 103. *Id.* at 14-15.

A. Rejections Over *Kung ‘558* in view of *Gainsboro ‘537*

Claims 1, 2, 4, 6, 7, 10-17, 23, 26, 27, 32, 33, 36, 41-43, 47, 48, 52, and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung ‘558* in view of *Gainsboro ‘537*. *Office Action* at p. 3. Applicant respectfully traverses.

1. Independent Claims 1, 12, and 26

Independent claim 1 as amended recites, in part, that:

said telephones are connected to said offsite public switched telephone network only under control of said programmable control computer and subject to said usage restriction.

Independent claim 12 as amended recites, in part, that:

said telephones are connected to said VoIP network only under control of said programmable control system and subject to said use restriction.

And independent claim 26 as amended recites, in part:

a VoIP gateway for translating signals from said telephones into data packets transmitted over said VoIP network to said offsite public switching network only under control of said control computer and subject to said usage restriction.

The Examiner has previously relied upon *Kung* '558 as disclosing these elements. However, *Kung* '558 admittedly does not disclose usage restrictions, and therefore it does not teach or suggest, for instance, telephones that are connected to an offsite PSTN only under control of said programmable control computer and subject to a usage restriction, as recited in amended claim 1. See *Office Action* at pp. 5 and 6. Similar arguments apply to claims 12 and 26.

In fact, the Examiner has relied upon *Gainsboro* '537 as teaching or suggesting usage restrictions. Particularly, the Examiner has stated that it would have been obvious to restrict usage by particular individuals in *Kung*'s system in order "to mitigate harassment problems." *Office Action* at p. 6. However, *Kung* '558 discloses the implementation of a call waiting feature in a generic packetized network, whereas *Gainsboro* '537 discloses an apparatus specific for use with institutional environments. See e.g., *Kung* '558 at Abstract; *Gainsboro* '537 at Abstract. Clearly, the problems discussed in *Gainsboro* '537 are particular to institutional environments, and do not exist in *Kung*. *Gainsboro* '537 at ¶ [0002]. In other words, there is no reason why a person of ordinary skill in the art would be inclined to solve "harassment problems" in *Kung* '558.

Moreover, Applicant respectfully disagrees with the proposition that elements of *Gainsboro* '537 and *Kung* '558 can indeed be combined, as proposed by the Examiner. Specifically, *Kung*'s IP central station (200) interfaces with a packetized communication system via an IP network (120). *Kung* '558 at Figure 1. Meanwhile, *Gainsboro* '537's computer or

CCU (3) controls telephone access in a public switched telephone network (PSTN) or plain old telephone service (POTS) environment via a trunk management unit or TMU (2) based upon DTMF tones captured by TMU (2). *Gainsboro '537* at ¶¶ [0014]-[0016]; Figure 1. In contrast with *Gainsboro '537*'s system, *Kung '558*'s IP central station (200) does not interact with telephones, and it does not exchange messages with a trunk management unit, such as *Gainsboro '537*'s TMU (2). *Kung '558* at ¶¶ [0042]-[0077]. Therefore, adding *Gainsboro '537*'s CCU (3) into *Kung '558*'s IP central station (200) would require a substantial reconstruction and redesign of the elements shown in *Kung '558*.

In addition, Applicant respectfully reminds the Examiner that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959), cited in M.P.E.P. § 2143.01(VI). In this case, *Kung '558* provides a communications system that allows the free exchange of telephone calls, messages, and the like. *Kung '558* at ¶¶ [0026] and [0037]; Figure 1. In fact, *Kung '558*'s operates to “expand[] the scope of traditional PSTN call waiting services by allowing a subscriber to be on one call and receive and place in a call queue, multiple [other] calls . . .” *Kung '558* at ¶ [0011]. Clearly, *Kung '558*'s main goal is to expand (not restrict) telephone calls being made. So, because the proposed combination of *Gainsboro '537*'s telephone restrictions with *Kung '558*'s system would change the principle of operation of *Kung '558* the teachings of the applied references are not sufficient to render the claims obvious.

In addressing the arguments set forth above, the Examiner seems to mistakenly believe that Applicant is contending that *Kung '558* and *Gainsboro '537* are non-analogous art. See *Office Action* at pp. 20-22. Applicant has not yet submitted such an argument. Instead, Applicant has specifically asserted that (1) there is no reason why a person of ordinary skill in the art would be inclined to solve “harassment problems” in *Kung '558*; that (2) adding *Gainsboro '537*'s CCU into *Kung '558*'s IP central station would require a substantial reconstruction and redesign of the elements shown in *Kung '558*; and that (3) the proposed

combination of *Gainsboro* '537's telephone restrictions with *Kung* '558's system would change the principle of operation of *Kung* '558. See M.P.E.P. § 2143. Applicant respectfully requests that the Examiner address Applicant's arguments as outlined herein.

Applicant has also previously submitted a Declaration by Robert L. Rae (*Declaration*) explaining the unexpectedly improved results provided by the claimed invention as evidence of non-obviousness. See *Declaration* submitted with the *Amendment Accompanying Request for Continued Examination* filed February 9, 2007. The *Declaration* also presented evidence that a person of ordinary skill in the art would not think that the claimed invention would actually work for its intended purpose. See *id.* In response to this evidence, the Examiner has stated that "the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the difference would otherwise be obvious." *Office Action* at p. 23, citing *Ex Parte Obiaya*, 227 U.S.P.Q. 58, 60 (Bd. Pat. App. & Inter. 1985). However, the Examiner's position improperly assumes that there is a suggestion in the references of record for the proposed combination, which Applicant disputes in light of the arguments presented herein.

The *Declaration* shows that a person of ordinary skill in the art would not consider combining *Kung* '558 with *Gainsboro* '537 because there would be no reasonable expectation of success. More specifically,

[i]t was believed that the forgoing and other call control functions would be *less effective* in providing usage restriction due to the nature of VoIP signals being fundamentally different than traditional PSTN signals. For example, detection of three-way calls often relies upon particular signal characteristics, such as an energy spike in a particular frequency range followed by very low energy at all frequencies. However, VoIP signals, through conversion from analog to digital and the use of compression etcetera, appreciably alter or suppress many such signal characteristics. Accordingly, the various usage restrictions were *not expected to provide as reliable operation* in VoIP as they did in a traditional PSTN network.

Declaration at p. 2. References can only be combined to reject claims as *prima facie* obvious when there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). In this case, Applicant has presented unrefuted evidence that a person of ordinary skill in the art would not expect call control functions to be successfully implemented with VoIP signals, and thus the combination of *Kung '558* with *Gainsboro '537* is improper.

Additionally, in *Obiaya* there was a finding that the proffered advantage would “flow naturally” from the suggestion of the prior art. *Obiaya*, 227 U.S.P.Q. at 60. In this case, however, the unexpected benefits of the present invention do not “naturally flow” from the references. As explained in more detail in the *Declaration*, certain of these benefits require that particular steps be taken to that end—*i.e.*, call control features would have to be specifically implemented or programmed. *See e.g.*, *Declaration* at p. 2.

Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 1, 12, and 26.

2. Dependent Claims 2, 4, 6, 7, 10, 11, 13-17, 23, and 27

As noted above, the combination of *Kung '558* with *Gainsboro '537* is improper. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 2, 4, 6, 7, 10, 11, 13-17, 23, and 27. Moreover, each of these dependent claims recites additional features not taught or suggested by the applied art.

For example, claim 2 recites that the “**programming for said programmable control computer is distributed to at least one remote location over said VoIP network.**” The Examiner relies upon *Kung '558*’s distributed processing controller (306) as meeting these elements. *Office Action* at p. 6. However, distributed processing controller (306) only controls broadband residential gateway (300). *Kung '558* at ¶ [0081]. Distributed processing controller (306) is not the programmable control computer, nor does it contain programming for the programmable control computer, which the Examiner has previously contended is met by *Kung*

'558's IP central station (200). *See Office Action* at pp. 3 and 6. The Examiner does not rely upon *Gainsboro '537* as teaching or suggesting these claimed elements, and Applicant asserts that it does not to do so. Therefore, the combination of *Kung '558* with *Gainsboro '537* does not teach or suggest every feature recited in claim 2. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 2.

Claim 4 recites **"at least one programmable control computer at each site, wherein said plurality of given sites are interconnected over said VoIP network."** The Examiner admits that the combination of *Kung '558* with *Gainsboro '537* does not teach or suggest every feature recited in claim 4. *Office Action* at p. 11. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 4.

Claim 10 recites that **"said gateway is an internal gateway,"** and claim 11 recites that **"said gateway is an external gateway shared with other VoIP devices outside of said programmable control computer."** The Examiner relies solely upon *Kung '558*'s head-end hub (115) as meeting these claimed elements. *Office Action* at pp. 13 and 14. However, Applicant has been unable to find any indication in *Kung '558* that its head-end hub (115) is an internal gateway or an external gateway shared with other VoIP devices outside of a programmable control computer, and the Examiner has not shown otherwise. Further, the Examiner does not rely upon *Gainsboro '537* as teaching or suggesting these claimed elements, and Applicant asserts that it does not to do so. Therefore, the combination of *Kung '558* with *Gainsboro '537* does not teach or suggest every feature recited in claims 10 and 11. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 10 and 11.

Claim 13 recites, in part, that **"at least some of said functions of said programmable control system are performed off of said site . . ."** The Examiner again states that *Kung '558*'s distributed processing controller (306) meets this element. *Office Action* at p. 6. However, distributed processing controller (306) only controls broadband residential gateway (300). *Kung '558* at ¶ [0081]. It is not the programmable control computer, nor does it perform

functions of said programmable control system, which the Examiner has previously contended is met by *Kung '558*'s IP central station (200). The Examiner does not rely upon *Gainsboro '537* as teaching or suggesting these claimed elements, and Applicant asserts that it does not do so. Therefore, the combination of *Kung '558* with *Gainsboro '537* does not teach or suggest every feature recited in claim 13. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 13.

Claim 16 recites that “**said programmable control system includes a control computer at each site.**” Again, the Examiner insists that *Kung '558*'s distributed processing controller (306) meets this element. *Office Action* at p. 6. However, distributed processing controller (306) only controls broadband residential gateway (300). *Kung '558* at ¶ [0081]. Again, distributed processing controller (306) is not the programmable control computer, which the Examiner has previously contended is met by *Kung '558*'s IP central station (200). *See Office Action* at pp. 3 and 6. The Examiner does not rely upon *Gainsboro '537* as teaching or suggesting these claimed elements, and Applicant asserts that it does not do so. Therefore, the combination of *Kung '558* with *Gainsboro '537* does not teach or suggest every feature recited in claim 16. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 16.

3. Independent Claim 32

Claim 32 recites, in part, “**a plurality of telephone terminals disposed at said prison facility, wherein access to said plurality of telephone terminals is provided by said prison facility . . .**” In support for this rejection, the Examiner has stated that because *Kung '558* discloses a system may be deployed in “a business or other location,” *Kung '558*'s system may also be used in a “prison facility.” *Office Action* at p. 9. Even assuming, *arguendo*, that prison facilities are encompassed by *Kung '558*'s “other locations,” that alone is not sufficient to establish a prima facie case of obviousness. Here, *Kung '558*'s system would not be suitable for use in a prison facility, which presents unique challenges unlike those found in a generic location. *See e.g.*, Specification, page 2, lines 6-15; page 3, line 8—page 4, line 9. Therefore,

although *Kung '558*'s system may be deployed in "a business or other location," there is no indication that its system would be successfully implemented in a "prison facility."

In addressing the foregoing remarks, the Examiner states that:

'prison facility,' Is [sic] nor [sic] claimed as such, in independent claims. If applicant prefers 'prison facility', then ishold [sic] be claimed that way.

Office Action at p. 23. However, contrary to the Examiner's statement, claim 32 is clearly limited for use in connection with a prison facility. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 112 rejection of record with respect to claim 32.

4. Dependent Claims 33, 36, 41, 42, and 53

As noted above, the combination of *Kung '558* with *Gainsboro '537* is improper. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 33, 36, 41, 42, and 53.

5. Independent Claim 43

Claim 43 recites, in part, "**coupling . . . a centralized system providing call control functions to a prison telephone system . . .**" and a "**telephone terminal coupled to said public switched telephone network only under control of said centralized system.**" For the same reasons put forth above with respect to claims 1, 12, and 26, Applicant respectfully asserts that claim 43 is patentable over the combination of *Kung '558* with *Gainsboro '537*. Additionally or alternatively, claim 42 is allowable for the same reasons presented with respect to claim 32. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 112 rejection of record with respect to claim 43.

6. Dependent Claims 47, 48, and 52

As noted above, the combination of *Kung '558* with *Gainsboro '537* is improper. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 47, 48, and 52.

B. Rejections Over *Kung '558* in view of *Gainsboro '537* and *Cell*

Claims 3 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and *Cell*. *Office Action* at p. 10. As noted above, the combination of *Kung '558* with *Gainsboro '537* is improper. Moreover, the Examiner states that the combination of *Kung '558* with *Gainsboro '537* and *Cell* would be obvious because “[t]he motivation for using VOIP gateway in IP central station is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source” *Id.* In response, Applicant respectfully asserts that the Examiner’s statement is circular and does not amount to an “apparent reason to combine.” In addition, there is no need to add other references’ teachings to *Kung '558* to establish a voice call connection with a VoIP gateway and receive audio data from a network source because *Kung '558* already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 3 and 22.

C. Rejections Over *Kung '558* in view of *Gainsboro '537* and *Vo*

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and *Vo*. *Office Action* at p. 10. As noted above, the combination of *Kung '558* with *Gainsboro '537* is improper. Moreover, the Examiner states that the combination of *Kung '558* with *Gainsboro '537* and *Vo* would be obvious because “[t]he motivation for using VOIP is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source” *Id.* In response, Applicant respectfully asserts that the Examiner’s statement is circular and does not amount to an “apparent reason to combine.” In addition, there is no need to add other references’ teachings to *Kung '558* to

establish a voice call connection with a VoIP gateway and receive audio data from a network source because *Kung '558* already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 4 and 5.

D. Rejections Over *Kung '558* in view of *Gainsboro '537* and *Kung '469*

Claims 8, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and *Kung '469*. *Office Action* at p. 11. First, it is unclear why the Examiner has based this rejection upon a combination with *Kung '469* without relying upon that reference as teaching or suggestion any of the claimed elements. *See Id* at pp. 11 and 12. Accordingly, Applicant respectfully requests that the Examiner clarify his position.

Further, each of claims 8 and 18 recites, in part, “**a system for imposing a three-way call restriction.**” The Examiner admits that *Kung '558* does not disclose this feature, and relies upon *Gainsboro '537* to provide the missing element. *Id* at p. 12. Particularly, the Examiner states that “*Gainsboro* discloses ‘It would be high desirable to provide a method ---for allowing a recipient of an undesired call from an inmate to easily and automatically prohibit all future calls from that particular inmate.’” *Id*. However, blocking a call from an inmate to a recipient is clearly not the same as imposing a three-way call restriction. Applicant notes that the Examiner has not relied upon any other reference as teaching or suggesting this feature, and that those references do not do so. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 8 and 18.

Claim 19 recites “**a first VoIP gateway disposed between said plurality of telephones and said VoIP network; and a second VoIP gateway disposed between said VoIP network and said offsite public switched telephone network.**” The Examiner relies solely upon *Kung '558*’s broadband residential gateway (300) and multimedia gateway (230) as meeting the first and second VoIP gateways recited in the claims. *Office Action* at p. 12. However, broadband residential gateway (300) is not a VoIP gateway. Moreover, multimedia gateway (230) is not

disposed between a VoIP network a PSTN. Applicant notes that the Examiner has not relied upon any other reference as teaching or suggesting this feature, and that those references do not do so. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 19.

E. Rejections Over *Kung '558* in view of *Gainsboro '537* and *Kung '360*

Claims 9, 21, 35, 49, and 55-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung '558* in view of *Gainsboro '537* and *Kung '360*. *Office Action* at p. 12. Claim 9 recites, in part, **“a system responsive to a personal identification number (PIN) keyed into at least one of said onsite public telephones for authorizing stored permitted telephone usage associated with said PIN,”** and claims 21 and 55-58 recite similar features. The Examiner relies solely upon *Kung '360* as disclosing these claimed features. *Id.* Particularly, the Examiner cites to a portion of *Kung '360* which states that:

[w]hen the subscriber arrives at a residential or public telephone station, the subscriber dials a toll-free number for location registration using either a PIN or some other personal information that uniquely identifies the subscriber. The network then automatically maps the telephone's location information with the directory number (DN) the caller wants to be forwarded.

Kung '360 at col. 29, lns. 45-60. The cited passage does not teach or suggest a system responsive to a PIN for authorizing stored permitted telephone usage associated with that PIN. Applicant notes that the Examiner has not relied upon any other reference as teaching or suggesting this feature, and that those references do not do so. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 19, 21, and 55-58.

Moreover, as noted above, the combination of *Kung '558* with *Gainsboro '537* is improper. The Examiner further states that the combination of *Kung '558* with *Gainsboro '537* and *Kung '360* would be obvious because “[t]he motivation for using VOIP is to identify the

caller and establish a voice call connection and receiving audio data from a network source.” *Id.* In response, Applicant respectfully asserts that the Examiner’s statement is circular and does not amount to an “apparent reason to combine.” In addition, there is no need to add other references’ teachings to *Kung ‘558* for the purpose of “establishing a voice call connection and receiving audio data from a network source” because *Kung ‘558* already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 9, 21, 35, 49, and 55-58.

F. Rejections Over *Kung ‘558* in view of *Gainsboro ‘537*, *Cell*, and *Weitz*

Claims 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung ‘558* in view of *Gainsboro ‘537*, *Cell*, and *Weitz*. *Office Action* at p. 14. As noted above, the combination of *Kung ‘558* with *Gainsboro ‘537* is improper. The Examiner further states that the combination of *Kung ‘558* with *Gainsboro ‘537*, *Cell*, and *Weitz* would be obvious because “[t]he motivation for using packetization is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.” *Id.* In response, Applicant respectfully asserts that the Examiner’s statement is circular and does not amount to an “apparent reason to combine.” In addition, there is no need to add other references’ teachings to *Kung ‘558* for the purpose of “establishing a voice call connection and receiving audio data from a network source” because *Kung ‘558* already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 28 and 29.

G. Rejections Over *Kung ‘558* in view of *Gainsboro ‘537*, *Cell*, and *Weitz*, and *Pogossiants*

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung ‘558* in view of *Gainsboro ‘537*, *Cell*, and *Weitz*, and *Pogossiants*. *Office Action* at p. 14. Claim 30 recites, in part, “**a three-way call detection system for imposing a three-way call restriction, said three-way call detection system being disposed between said second VoIP gateway and said public switched telephone network.**” The Examiner admits that a combination of *Kung*

'558 with *Gainsboro* '537, *Cell*, and *Weitz* does not teach or suggest the claimed feature, and relies upon *Pogossiants* as curing this deficiency. *Office Action* at pp. 14 and 15. However, the passage of *Pogossiants* cited by the Examiner is completely silent regarding a three-way call detection system. See at ¶¶ [0025] and [0090].

Furthermore, as noted above, the combination of *Kung* '558 with *Gainsboro* '537 is improper. The Examiner further states that the combination of *Kung* '558 with *Gainsboro* '537, *Cell*, *Weitz*, and *Pogossiants* would be obvious because "[t]he motivation for using packetization is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source." *Id.* In response, Applicant respectfully asserts that the Examiner's statement is circular and does not amount to an "apparent reason to combine." In addition, there is no need to add other references' teachings to *Kung* '558 for the purpose of "establishing a voice call connection with a VoIP gateway" and "receiving audio data from a network source" because *Kung* '558 already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 30.

H. Rejections Over *Kung* '558 in view of *Gainsboro* '537 and *Pogossiants*

Claims 20 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* '558 in view of *Gainsboro* '537 and *Pogossiants*. *Office Action* at p. 15. Claim 20 recites that "three-way call detection is performed between said second VoIP gateway and said public switched telephone network," and claim 30 recites similar elements. The Examiner admits that a combination of *Kung* '558 with *Gainsboro* '537 not teach or suggest the claimed feature, and relies upon *Pogossiants* as curing this deficiency. *Office Action* at p. 16. However, the passage of *Pogossiants* cited by the Examiner is completely silent regarding a three-way call detection system. See *Pogossiants* at ¶¶ [0025] and [0090].

Furthermore, as noted above, the combination of *Kung* '558 with *Gainsboro* '537 is improper. The Examiner further states that the combination of *Kung* '558 with *Gainsboro* '537

and *Pogossiants* would be obvious because “[t]he motivation for using VOIP is to establish a VoIP telephone calling.” *Id.* In response, Applicant respectfully asserts that the Examiner’s statement is circular and does not amount to an “apparent reason to combine.” In addition, there is no need to add other references’ teachings to *Kung* ‘558 for the purpose of establishing VoIP telephone calling because *Kung* ‘558 already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 20 and 30.

I. Rejections Over *Kung* ‘558 in view of *Gainsboro* ‘537 and *Weitz*

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* ‘558 in view of *Gainsboro* ‘537 and *Weitz*. *Office Action* at p. 16. As noted above, the combination of *Kung* ‘558 with *Gainsboro* ‘537 is improper. The Examiner further states that the combination of *Kung* ‘558 with *Gainsboro* ‘537 and *Weitz* would be obvious because “[t]he motivation for using VOIP is to establish a VoIP telephone calling.” *Id.* at p. 17. In response, Applicant respectfully asserts that the Examiner’s statement is circular and does not amount to an “apparent reason to combine.” In addition, there is no need to add other references’ teachings to *Kung* ‘558 for the purpose of establishing VoIP telephone calling because *Kung* ‘558 already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 24 and 25.

J. Rejections Over *Kung* ‘558 in view of *Gainsboro* ‘537 and *Gainsboro* ‘583

Claims 34, 37, 39, 44, 45, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* ‘558 in view of *Gainsboro* ‘537 and *Gainsboro* ‘583. *Office Action* at p. 17. As noted above, the combination of *Kung* ‘558 with *Gainsboro* ‘537 is improper. For at least the same reasons, the combination of *Kung* ‘558 and *Gainsboro* ‘537 with *Gainsboro* ‘583 is also improper. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 34, 37, 39, 44, 45, and 50.

K. Rejections Over *Kung* '558 in view of *Gainsboro* '537 and *Peel*

Claims 38, 39, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* '558 in view of *Gainsboro* '537 and *Peel*. *Office Action* at p. 18. As noted above, the combination of *Kung* '558 with *Gainsboro* '537 is improper. The Examiner further states that the combination of *Kung* '558 with *Gainsboro* '537 and *Peel* would be obvious because "[t]he motivation for using VOIP is to establish a VoIP telephone calling." *Id* at p. 18. In response, Applicant respectfully asserts that the Examiner's statement is circular and does not amount to an "apparent reason to combine." In addition, there is no need to add other references' teachings to *Kung* '558 for the purpose of establishing VoIP telephone calling because *Kung* '558 already provides VoIP functionality. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 38, 39, and 51.

L. Rejections Over *Kung* '558 in view of *Ziegler*

Claims 40 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* '558 in view of *Ziegler*. *Office Action* at p. 18. Claim 40 recites that "**said processor-based system provides real time call recording,**" and claim 46 recites that "**said centralized system provides call recording with respect to said call.**" The Examiner admits that *Kung* '558 does not teach or suggest these claimed elements, and relies solely upon *Ziegler* as providing these features. However, the passage of *Ziegler* cited by the Examiner only discloses gathering call usage records, not recording the call itself. *Ziegler* at ¶ [0013]. Applicant has been unable to find any passage of *Ziegler* that teaches or suggests the claimed features. Therefore, the combination of *Kung* '558 with *Ziegler* does not teach or suggest every claimed element. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 40 and 46.

VI. **Conclusion**

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 63134/P026US/10400589 from which the undersigned is authorized to draw.

Dated: June 22, 2007

Respectfully submitted,

By R. Ross Viguet

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: June 22, 2007

Signature: Joy H. Perigo

Joy H. Perigo